

## **REMARKS**

Claims 1-17 and 38-45 are pending in the case, claims 18-37 having previously been canceled and claim 45 having previously been added. Claims 8 and 10 have been withdrawn from consideration through restriction. The Office rejected:

- claims 1-5, 7, 11-17, 38 and 40-45 as anticipated under 35 U.S.C. §102(b) by U.S. Letters Patent 6,219,620 (“Park”);
- claim 6 as obvious under 35 U.S.C. §103(a) by Park in combination with U.S. Letters Patent 4,885,724 (“Read”); and
- claims 9 and 39 as obvious under 35 U.S.C. §103(a) by Park in combination with U.S. Letters Patent 6,226,601 (“Longaker”).

Applicant maintain their traversal of each of the rejections.

### **I. ALL CLAIMS ARE ALLOWABLE**

#### **A. THE OFFICE STILL MISCONSTRUES PARK**

The Office maintained all three sets of rejections: one set of anticipation rejections and two sets of obviousness rejections. All of the rejections rely on U.S. Letters Patent 6,219,620 (“Park”) to anticipate the independent claims 1 and 38. Applicant earlier argued that both of the independent claims 1 and 38 contemplate multiple transmitters in a cell and that one of those transmitters serve as the gateway to the independent pathway for all the transmitters—*i.e.*;

- claim 1 recites, “a plurality of cells each containing a portion of the data sources and their associated transmitters, *one of the transmitters within each cell also serving as a gateway for receiving data transmitted from the other data source transmitters within the cell*” (emphasis added);
- claim 38 recites, “the seismic data sources being organized into a plurality of cells, *one of the transmitters within each cell also serving as a gateway for receiving data transmitted form the other data source transmitters within the cell*” (emphasis added).

In each case, there are multiple transmitters in each cell, one of which transmits data from the other transmitters and thereby serves as a gateway for the others.

The Office responded, in essence, that the CAN 16 of Park met this limitation:

These arguments are not persuasive because each transmitter 16 acts as a gateway for the other transmitters of data 10 in each cell. Each remote acquisition unit 10 is associated with the data sources. In the portion of Park cited by the applicant (Fig. 1 and Column 2), Park disclose that "each RAU 10 can receive signal from and transmit signals to a central control unit (CCU) 12 using wireless telemetry." Because the RAUs transmit data from data sources, they meet the limitation the transmitters in applicant's claims. Park further notes that each cell has a "transmitter/receiver or cell access node (CAN) 16 acting as a relay between the RAUs 10 and the CCU 12." *This CAN 16 is also associated with the data sources and is the transmitter that acts as a gateway in each cell.* In Park, the RAUs 10 and CAN 16 are the transmitters in each cell, as both RAUs and CAN transmit data from the data sources towards the central

("final" Office Action dated December 4, 2008, "Detailed Action", p. 2) This is clearly wrong—the CAN 16 is not associated with data sources in the same way as the RAUs 10 because it is not a "data transmitter". Thus, the CAN 16, by virtue of this difference, cannot perform as a gateway as recited by the claims.

For either an anticipation or an obviousness rejection, the cited art must teach all the limitations of the claims. M.P.E.P. §706.02(j), 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990) (anticipation); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974) (obviousness). A careful comparison of Park and these claims reveals that Park in fact fails to anticipate them. All of the rejections therefore fail regardless of whether for anticipation or obviousness.

## **B. THE OFFICE MISAPPLIES M.P.E.P. §2114**

The Office misapplies M.P.E.P. §2114. It is true that this provision states that, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." However, the legal principle is being misapplied here in this case.

The lead case cited in M.P.E.P. §2114 is *In re Scheiber*, 44 U.S.P.Q.2d (BNA) 1429 (Fed. Cir. 1997). At the outset, the Court establishes that all the structure of Schreiber's claim was previously disclosed, and that he was relying on the use to which his apparatus was put for patentability:

*There is no dispute that the structural limitations recited in Schreiber's application are all found in the Harz reference upon*

which the examiner and the Board relied. Thus, to use the terms found in Schreiber's claim 1, Harz discloses a “dispensing top” that has “a generally conical shape and an opening at each end,” and “means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform.” *Schreiber argues, however, that Harz does not disclose that such a structure can be used to dispense popcorn from an open-ended popcorn container.*

*Id.*, at 1431 (emphasis added). Thus, Schreiber is immediately distinguishable from the present case—the CAN 16 is not capable of meeting the functional limitations of the subject claims.

After dismissing Schreiber’s non-analogous art argument as inapplicable in a novelty context, the Court then turned to whether the functional limitation on which Schreiber relied was inherent in the prior art:

*The examiner and the Board both addressed the question whether the functional limitations of Schreiber's claim gave it patentable weight and concluded that they did not, because those limitations were found to be inherent in the Harz prior art reference. ...For that reason, the examiner was justified in concluding that the opening of a conically shaped top as disclosed by Harz is inherently of a size sufficient to “allow [ ] several kernels of popped popcorn to pass through at the same time” and that the taper of Harz's conically shaped top is inherently of such a shape “as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container.” The examiner therefore correctly found that Harz established a prima facie case of anticipation.*

*Id.*, at 1432 (emphasis added). The mere fact that the Office even addresses the inherency of this functionality refutes the Office’s characterization of the decision’s holding. If there can be no patentable distinction based on functionality, then why even consider the issue? *The clear reason is that patentability for an apparatus claim can in fact be predicated on functional limitations.*

The Court then implicitly confirmed that claimed functionality can patentably distinguish apparatus claims:

*At that point, the burden shifted to Schreiber to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus. The Board found that Schreiber failed to do so, and we agree.*

*Id.*, at 1432 (citations omitted). The clear implication here is that Schreiber’s apparatus claim would have been allowable if only Schreiber had been able to demonstrate that the prior art reference did inherently possess the claimed functionality.

More particularly, M.P.E.P. §2114 is an elaboration on the legalism that “a new use for an old apparatus does not make the new apparatus patentable.” The lead case cited by the Office in this section, *In re Scheiber*, 55 U.S.P.Q.2d (BNA) 1429 (Fed. Cir. 1997), states this principle directly, but the second case contains the fuller statement:

...In the first place, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.

*In re Swinehart*, 169 U.S.P.Q. (BNA) 226, 229 (C.C.P.A. 1971).

This legalism, around which all of M.P.E.P. §2114 is built, is therefore merely a restatement of the legal principle that a reference can inherently anticipate a claim. This is evident from the Office’s lead case *Schreiber*. In *Schreiber*, the Applicant was arguing patentability regarding certain functional aspects of an apparatus. *Id.*, at 1430-31. The court’s analysis began with a brief statement of the law on anticipation and inherency, at 1431; set forth the legalism under discussion here, *id.*; and then went on to find that the argued functional limitation was indeed inherently disclosed in the prior art, at 1432-43.

Thus, if the “functional limitations” to be ignored by the Office were, for example, “stopping the motion of a door”, then the legal principle would be *apropos*. One cannot patent “a doorstop comprising a computing apparatus stopping the movement of a door,” because any computing apparatus can be used in that fashion. It is a property “inherently possessed” by any prior art computing apparatus. However, that is not the case with the functional limitations of the instant claims.

Furthermore, the position that the Office extrapolates from M.P.E.P. §2114 is contrary to law. As evidence that the Office misapplied M.P.E.P. §2114, the *Swinehart* decision cited therein and quoted above reversed the rejection of a claim directed to a composition of matter in which the patentable distinction arose from a functional limitation. *Swinehart*, 169 U.S.P.Q. (BNA) at 228, 230.

If the Office chooses to reject any claim based upon this section, Applicant respectfully submits that it must establish *prima facie* that the functional limitations are inherent in the prior art. Note that inherency is not applicable in the obviousness context in which this analysis is occurring. “That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248, 1250 (Fed. Cir. 1989), quoting *In re Spormann*, 150 U.S.P.Q. (BNA) 449, 452 (C.C.P.A. 1966); *In re*

*Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), also quoting *Spormann*, at 452. Regardless, Applicant respectfully submits that the function of, for example, controlling the position of the seismic spread using the measured horizontal component of the current is not an inherent function of spread controllers.

Thus, the case law on which the Office merely reaffirms the legal principle that a reference may inherently anticipate a claim and the adage that a new use for an old apparatus does not make the old apparatus patentable. To properly dismiss Applicant's functional limitations out of hand as insufficient to impart patentability, the Office has to establish that Park's apparatus inherently performs those functions. The Office has not done this. Accordingly, the Office's misapplication of M.P.E.P. §2114 errs as a matter of law.

## **II. THE RESTRICTION REQUIREMENT IS STILL IMPROPER**

Applicant once again requests reconsideration of the restriction requirement. The Office held there were no shared special technical features "as evidenced by the rejections presented below." (Office Action dated April 11, 2008, "Detailed Action", p. 2) However, as is established above, the analysis upon which the Office relies rests upon the Office's mistaken construction of the claims and/or the references and an error of law. Accordingly, Applicant respectfully submits that a "special technical feature" is present. Furthermore, that feature is present in the independent claims which are allowable and generic to the withdrawn claims. The withdrawn claims should therefore be rejoined.

## **III. CONCLUDING REMARKS**

Applicants therefore respectfully submit that the claims are in condition for allowance, and requests that they be allowed to issue. The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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